

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed July 30, 2007. Through this response, claims 1, 19, and 21 have been amended. Reconsideration and allowance of the application and pending claims 1-10 and 13-21 are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(b)

A. Statement of the Rejection

Claims 1-7, 13-15, 19 and 20 have been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by *Kanamori et al.* ("Kanamori," U.S. Pat. No. 6,138,826). Applicants respectfully submit that the rejection to claims 1-7, 13-15, 19 and 20 has been rendered moot, and that claims 1-7, 13-15, 19, and 20 are allowable over *Kanamori*.

B. Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the *Kanamori* reference. Applicants discuss the *Kanamori* reference and Applicants' claims in the following.

Independent Claim 1

Claim 1 recites (with emphasis added):

1. An image capture system comprising:
 - a digital camera, the digital camera comprising at least a photosensor and a first processor; and
 - an enclosure configured to receive the digital camera, configured to have a plurality of features controlling operation of the digital camera, and configured to capture an image using the photosensor of the digital camera, the plurality of features each increasing operational sophistication of the digital camera, the enclosure further including a **second processor that electrically communicates with the photosensor over conductive paths and through coupling connectors that are collectively devoid of any intermediary active electronic component located between the second processor and the photosensor**, the second processor used in conjunction with the first processor to control the capture of an image on the photosensor.

As explained above, the above-described amendments to independent claim 1 have rendered the rejection to claim 1 moot. Additionally, Applicants respectfully submit that *Kanamori* does not disclose, teach, or suggest at least the above-emphasized claim features. As set forth on page 3 of the Office Action (emphasis added):

It should be noted that the processor of the enclosure is connected to the image sensor of the digital camera by virtue of an intermediate processor (first processor) of the digital camera in order for the combined enclosure and digital camera to function as disclosed.

Assuming *arguendo* the allegation to be true, Applicants respectfully note that the intermediate processor represents an “intermediary electronic component” located between the second processor and the photosensor, and hence would not teach or disclose the above-emphasized claim features that requires there be no such intermediary active (as opposed to passive) electronic component in the path comprising the conductive paths and coupling connectors connecting the two components. Hence, Applicants respectfully submit that claim 1 is allowable over *Kanamori*, and respectfully request that the rejection be withdrawn.

Because independent claim 1 is allowable over *Kanamori*, dependent claims 2-7 and 13-15 are allowable as a matter of law for at least the reason that the dependent claims 2-7 and 13-15 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 19

Claim 19 recites (with emphasis added):

19. A method for capturing images, the method comprising the steps of:
 - coupling a digital camera and an enclosure, the digital camera residing within a recess of the enclosure;
 - providing a plurality of image capture features on the enclosure, the plurality of image capture features controlling operation of the digital camera, the plurality of image capture features each increasing operational sophistication of the digital camera;
 - selecting at least one image capture feature among the plurality of image capture features using a device residing on the enclosure; and
 - capturing an image on a photosensor residing in the digital camera, the image captured through a lens residing on the camera enclosure, wherein control of the capture of the image resides in a combination of a first processor and a second processor both connected to the photosensor and residing in the digital camera and the enclosure, respectively, ***the second processor in electrical communication with the photosensor over conductive paths and through coupling connectors that are collectively devoid of any intermediary active electronic component located between second processor and the photosensor.***

As explained above, the above-described amendments to independent claim 19 have rendered the rejection to claim 19 moot. Additionally, for similar reasons presented above in association with independent claim 1, Applicants respectfully submit that *Kanamori* does not disclose, teach, or suggest at least the above-emphasized claim features. Hence, Applicants respectfully submit that claim 19 is allowable over *Kanamori*, and respectfully request that the rejection be withdrawn.

Because independent claim 19 is allowable over *Kanamori*, dependent claim 20 is allowable as a matter of law.

Due to the shortcomings of the *Kanamori* reference described in the foregoing, Applicants respectfully assert that *Kanamori* does not anticipate Applicants' claims. Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

A. Statement of the Rejection

Claims 8 and 9 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Kanamori* in view of *Takematsu et al.* ("*Takematsu*," U.S. Pat. Pub. No. 2003/0214593 A1). Claims 10 and 21 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Kanamori* in view of *Da Silva* ("*Da Silva*," U.S. Pat. No. 6,819,866 B2). Claims 16 and 18 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Kanamori* in view of *Inoue et al.* ("*Inoue*," U.S. Pat. No. 5,822,622). Claim 17 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Kanamori* in view of *Inoue* and in further view of *Niikawa et al.* ("*Niikawa*," U.S. Pat. Pub. No. 2001/0043279 A1). Applicants respectfully submit that these rejections have been rendered moot in view of the amendments to the claims. Further, Applicants respectfully submit that the above-identified claims are allowable over the art of record.

B. Discussion of the Rejection

The U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquires, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;

- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record, and hence respectfully request that the rejections be withdrawn for at least the following reasons.

Dependent Claims 8 and 9

As explained above, Applicants respectfully submit that *Kanamori* does not disclose, teach, or suggest at least the above-emphasized features of independent claim 1. Additionally, Applicants respectfully submit that *Takematsu* fails to remedy these deficiencies. For instance, it is respectfully noted that the Office Action relies solely upon *Kanamori* for the claimed connectivity between the photosensor and first and second processors (see pages 3 and 4 of the Office Action). Since claims 8 and 9 incorporate at least the allowable claim features of claim 1, dependent claims 8 and 9 are allowable as a matter of law.

Further, Applicants respectfully submit that claims 8 and 9 are allowable on separate grounds. Claims 8 and 9 provide as follows:

8. The image capture system of claim 1, wherein the enclosure further comprises **a coupler configured to receive a flash attachment**, and wherein the digital camera is configured to cause the flash attachment to flash.

9. The image capture system of claim 1, wherein the digital camera further comprises **a first ergonomic grip** and the enclosure further comprises a second ergonomic grip, the second ergonomic grip larger than the first ergonomic grip.

The Office Action alleges the following with regard to claim 8 (pages 10 and 11):

Kanamori does not explicitly teach that the enclosure further comprises a coupler configured to receive a flash attachment, and wherein the digital

camera is configured to cause the flash attachment to flash. However, in the reference to Takematsu, a digital camera (15) enclosed in a waterproof housing (9) is taught...The waterproof housing includes both a built-in flash (3) and an external flash (11) attached to a coupler (7) of the housing...it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the enclosure of Kanamori to include a coupler configured to receive a flash attachment such that the digital camera would be configured to cause the flash attachment and/or the built-in flash of the enclosure to flash during photography so as to obtain good photographs with right exposures under different lighting conditions as suggested by Takematsu.

Applicants respectfully disagree that the combination of *Kanamori* and *Takematsu* is obvious. *Kanamori* provides as part of its enclosure a flash device 28 "built in the case body 12." (see col. 5, lines 20-21 of *Kanamori*). *Takematsu*, on the other hand, does not have the flash integrated with the housing. To provide a coupler to receive a flash attachment is both superfluous to *Kanamori* and would appear to require extensive reworking of the case body and modification of the required electronics to enable the flash, which are two alterations that would tend to teach away from their combination for the claimed features. Accordingly, Applicants respectfully submit that the combination of *Kanamori* and *Takematsu* is not obvious as applied to claim 8, and hence respectfully request that the rejection be withdrawn for these additional reasons.

With regard to claim 9, the Office action alleges the following (pages 11 and 12):

Kanamori, however, does not explicitly disclose that the first grip is an ergonomic grip....As taught by *Takematsu*, a digital camera (15) comprises an ergonomic grip (under shutter button 3 shown in Fig. 3 and paragraphs [0029] & [0030])...Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the digital camera of *Kanamori* with an ergonomic grip which is smaller than the ergonomic grip of the waterproof case to provide better and comfortable handling of the digital camera when the digital camera is detached from the housing to operate as a stand alone device.

Applicants respectfully disagree that the combination of *Kanamori* and *Takematsu* discloses, teaches, or suggests that the digital camera has an ergonomic grip. The paragraphs of *Takematsu* referenced above provide as follows:

[0029] The invention is applicable to digital cameras of both the single-lens reflex type and the compact non-single-lens reflex type, although it will be described below only for the case of the former type.

[0030] FIG. 1 is a front view of a flash system embodying this invention, including a housing 9 with a camera inside, and FIG. 2 is a front view of the housing 9. FIG. 3 is a sectional view of the housing 9 with a camera 15 inside. The housing 9 is of a waterproof structure and contains not only the camera 15 but also a battery 16 as a power source and a device unit 18 including various devices. On the exterior of the housing 9 are a shutter button 33 of the camera 15, a front plate 4 made of a glass or acryl material, an illumination lamp 3, an operation button 6 and two light signal outputting terminals 2 and 7.

Nothing in these or other sections of *Takematsu* discloses, teaches, or suggests that the grip of the digital camera is an ergonomic grip. Accordingly, Applicants respectfully request that the rejection to claim 9 be withdrawn for these additional reasons.

Dependent Claims 10 and 21

Independent Claim 21

Claim 21 recites (with emphasis added):

21. A method for capturing images, the method comprising the steps of:
 - generating an image capture instruction using a remote device communicatively coupled to an enclosure;
 - communicating the image capture instruction to a digital camera coupled to the enclosure and residing within a recess of the enclosure; and
 - capturing an image with a photosensor residing in the digital camera, the step of capturing performed in accordance with the received image capture instruction, the step of capturing implemented under control of a combination of a first processor residing in the digital camera and a second processor residing in the enclosure, the first processor and the second processor connected to the photosensor, ***the second processor in electrical communication with the photosensor over conductive paths and through coupling connectors that are collectively devoid of any intermediary active electronic component located between second processor and the photosensor.***

As explained above, the above-described amendments to independent claim 21 have rendered the rejection to claim 21 moot. Additionally, Applicants respectfully submit that

Kanamori in view of *Da Silva* does not disclose, teach, or suggest at least the above-emphasized claim features. As set forth above, and for similar reasons, Applicants respectfully submit that *Kanamori* does not disclose, teach, or suggest at least the above-emphasized features. Additionally, Applicants respectfully submit that *Da Silva* fails to remedy these deficiencies. For instance, it is respectfully noted that the Office Action relies solely upon *Kanamori* for the claimed connectivity between the photosensor and first and second processors (see pages 3 and 4 of the Office Action). Hence, Applicants respectfully submit that claim 21 is allowable over *Kanamori* and *Da Silva*, and respectfully request that the rejection to claim 21 be withdrawn.

Further, with regard to claim 10, Applicants respectfully submit that for at least the reasons that *Kanamori* and *Da Silva* do not disclose, teach, or suggest at least the above-emphasized features of independent claim 1, which are incorporated into dependent claim 10, dependent claim 10 is allowable as a matter of law. Hence, Applicants respectfully request that the rejection to claim 10 be withdrawn.

Dependent Claims 16 and 18

As explained above, Applicants respectfully submit that *Kanamori* does not disclose, teach, or suggest at least the above-emphasized features of independent claim 1. Additionally, Applicants respectfully submit that *Inoue* fails to remedy these deficiencies. For instance, it is respectfully noted that the Office Action relies solely upon *Kanamori* for the claimed connectivity between the photosensor and first and second processors (see pages 3 and 4 of the Office Action). Since claims 16 and 18 incorporate at least the allowable claim features of claim 1, dependent claims 16 and 18 are allowable as a matter of law. Hence, Applicants respectfully request that the rejection to claims 16 and 18 be withdrawn.

Dependent Claim 17

As explained above, Applicants respectfully submit that *Kanamori* does not disclose, teach, or suggest at least the above-emphasized features of independent claim 1. Additionally, Applicants respectfully submit that *Inoue* and *Niikawa* fail to remedy these deficiencies. For instance, it is respectfully noted that the Office Action relies solely upon *Kanamori* for the claimed connectivity between the photosensor and first and second processors (see pages 3 and 4 of the Office Action). Since claim 17 incorporates at least the allowable claim features of claim 1, dependent claim 17 is allowable as a matter of law. Hence, Applicants respectfully request that the rejection to claim 17 be withdrawn.

Additionally, Applicants respectfully submit that dependent claim 17 is allowable on additional grounds. For instance, Applicants respectfully submit that the combination of *Kanamori*, *Inoue*, and *Niikawa* is not obvious as applied to claim 17. Claim 17 recites:

17. The image capture system of claim 14, wherein the enclosure further comprises an aperture ring residing on the enclosure and configured to adjust an aperture used when capturing the image.

Even assuming *arguendo* *Niikawa* discloses an aperture ring, it is not obvious to place the aperture ring on the enclosure that surrounds the digital camera. *Niikawa* does not disclose, teach, or suggest an enclosure (e.g., waterproof or otherwise) for the digital camera.

Further, an aperture ring added to the camera/enclosure of *Kanamori* would likely alter operation, or at the very least, provide a superfluous function, since exposure control appears to an automatic function with manual correction via a button. For instance, *Kanamori* provides as follows (col. 6, lines 42-66):

Sliding the power switch 64 upward in FIG. 2 turns on the power of the digital camera 18, and re-sliding the power switch 64 upward turns off the power of the digital camera 18. The mode dial 66 is used to select one of the following modes in accordance with the rotational position of the dial: a reproduction mode for reproducing a recorded image, a normal (AUTO) image-capturing mode for automatically controlling the exposure and focusing in accordance with the shooting conditions, a long shot fixed image-capturing mode for fixing a focus at a long distance (approximately 5 m), a close-up fixed image-capturing mode for fixing a focus at a short distance (approximately 1.2 m), and a macro image-

capturing mode for a close shot of 10-70 cm.

When the release button 34 is half pressed while the exposure correction button 68 is pressed, the exposure correction of +1.6 Ev is performed. The flash device 28, which is built in the case body 12, is normally in an automatic mode for automatically emitting light at a low brightness or in backlight. Every time the flash button 70 is pressed, the flash device 28 is changed from the automatic mode to a compulsory emission mode, an emission stop mode, and the automatic mode in that order. The exposure correction button 68 and the flash button 70 are also used to give an instruction to switch reproduced images forward and backward frame-by-frame basis in the reproduction mode.

Additionally, *Inoue* makes no mention of exposure or aperture ring. Accordingly, the combination does not disclose, teach, or suggest all the features of claim 17, and given the disparate systems and mechanisms of operation among the combined references, it is both unreasonable to combine the references and clearly not obvious to combine the references. Accordingly, Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/dr/

David Rodack
Registration No. 47,034

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500